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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,309	08/24/2001	Yoichiro Sako	7246/63317	2273
530 7590 09/16/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER SHERR, CRISTINA O				
ART UNIT		PAPER NUMBER		
3685				
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09/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/914,309

Applicant(s)

SAKO ET AL.

Examiner

CRISTINA SHERR

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 41, 42, 45, 46, 48-50 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 41-42, 45-46, 48-50, and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action is in response to Applicant's Amendment filed April 21, 2009. Claims 1, 3-5, 41-42, 45-46, 48-50, and 52 are currently pending in this case. Claims 2, 6-40, 43-44, 47, 51, and 53-64 were previously canceled. Claims 1, 4, 41, and 45 are currently amended.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 16, 2009 has been entered.

Response to Arguments

3. Applicant's arguments filed April 21, 2009 have been fully considered but they are not persuasive.

4. Applicant argues, regarding claims 1, 4, 41, and 45 as currently amended, that nothing in the cited prior art, teaches, discloses or suggests a controller configured to inhibit the receiving unit from one of the use of and operation of the use permission data while the controller is sending the use history information . . .

5. Examiner respectfully disagrees and directs attention to Stefik 2 at, e.g. fig 17 steps 1709 -1714. While Stefik2 does not specifically disclose the trait above, Stefik2 does disclose use history information, such as how many copies have been made or

how many times a document has been accessed, is being monitored, updated and sent to the external device. By default, a preset value would be, at least the value at which no more uses are left, such as when the full number of copies have been made or when the document has been accessed the full number of times or for the full number of hours. (see col 21 ln 15-25). Further, at fig 17 steps 1709-1714, Stefik2 discloses checking/updating use history information, such as how many copies have already been made and based on that check permitting or not permitting the receiving unit to use or copy the data. It would be a predictable result to first check/update and only afterwards to permit the use of the data, thus in effect inhibiting the receiving unit from using the data while the check/update/history is sent rather than letting the receiving unit start using/copying the data only to later learn that such use should not have been permitted. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

6. Applicants further, argue, regarding the section 103 rejections of claims 1, 4, 41, and 45, that nothing in the cited prior art discloses, teaches, or suggests a controller configured to send the use history information to the external device through the communication unit when an accumulation of uses of the data reaches a preset value.
7. Examiner respectfully disagrees and directs attention to Stefik2, where

Use-Duration" is used to define an indeterminate (or "open") start time. It sets limits on a continuous period of time over which the contents are accessible. The period starts on the first access and ends after the duration has passed or the expiration date is reached, whichever comes first. For example, if the right gives 10 hours of continuous access, the use-duration would begin when the first access was made and end 10 hours later.

Grammar element 1515 "Meter-Time:=Time-Remaining: Remaining-Use" is used to define a "meter time," that is, a measure of the time that the right is actually exercised. It differs from the Sliding-Interval specification in that the time that the digital work is in use need not be continuous. For example, if the rights guarantee three days of access, those days could be spread out over a month. With this specification, the rights can be exercised until the meter time is exhausted or the expiration date is reached, whichever comes first.

Remaining-Use:=Time-Unit

Start-Time:=Time-Unit

Use-Duration:=Time-Unit

All of the time specifications include time-unit specifications in their ultimate instantiation. (col 22 ln 10-30)

Also,

Grammar element 1510 "Copy-Count:=(Copies: positive-integer.vertline.0.vertline.unlimited)" provides a condition which defines the number of "copies" of a work subject to the right. A copy count can be 0, a fixed number, or unlimited. The copy-count is associated with each right, as opposed to there being just a single copy-count for the digital work. The Copy-Count for a right is decremented each time that a right is exercised. When the Copy-Count equals zero, the right can no longer be exercised. If the Copy-Count is not specified, the default is one. (col 21 ln 15-25).

8. In both of these cases, use history information, such as how many copies have been made or how many times a document has been accessed, is being monitored, updated and sent to the external device. By default, a preet5 value would be, at least the value at which no more uses are left, such as when the full number of copies have

been made or when the document has been accessed the full number of times or for the full number of hours.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3-5, 41-42, 45-46, 48-50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al (US 6,233,684) ("Stefik1") in view of Stefik et al (US 5,628,980) ("Stefik2").

Regarding claims 1, 4, 41, and 45 –

Stefik1 discloses a digital data processing apparatus (fig 4) comprising:

a communicating unit configured to communicate with an external device (e.g. fig 1, fig 3);

a receiving unit configured to receive digital data from a recording medium or through the communication unit, use of the received digital data employ use permission data (e.g. fig 5; fig 6; col 9 14-28; col 8 ln 5-38);

a memory in which use history information of the digital data has been stored; (col 10 ln 6-18).

11. Stefik2 discloses, where Stefik1 does not, a controller configured to send the use history information to the external device through the communication unit when an

accumulation of uses of the digital data reaches a preset value. (e.g. col 22 ln 57- col 23 10). Note also that in Stefik2, where

Use-Duration" is used to define an indeterminate (or "open") start time. It sets limits on a continuous period of time over which the contents are accessible. The period starts on the first access and ends after the duration has passed or the expiration date is reached, whichever comes first. For example, if the right gives 10 hours of continuous access, the use-duration would begin when the first access was made and end 10 hours later.

Grammar element 1515 "Meter-Time:=Time-Remaining: Remaining-Use" is used to define a "meter time," that is, a measure of the time that the right is actually exercised. It differs from the Sliding-Interval specification in that the time that the digital work is in use need not be continuous. For example, if the rights guarantee three days of access, those days could be spread out over a month. With this specification, the rights can be exercised until the meter time is exhausted or the expiration date is reached, whichever comes first.

Remaining-Use:=Time-Unit

Start-Time:=Time-Unit

Use-Duration:=Time-Unit

All of the time specifications include time-unit specifications in their ultimate instantiation. (col 22 ln 10-30)

Also,

Grammar element 1510 "Copy-Count:=(Copies: positive-integer.vertline.0.vertline.unlimited)" provides a condition which defines the number of "copies" of a work subject to the right. A copy count can be 0, a fixed number, or unlimited. The copy-count is associated with each right, as opposed to there being just

a single copy-count for the digital work. The Copy-Count for a right is decremented each time that a right is exercised. When the Copy-Count equals zero, the right can no longer be exercised. If the Copy-Count is not specified, the default is one. (col 21 ln 15-25).

12. In both of these cases, use history information, such as how many copies have been made or how many times a document has been accessed, is being monitored, updated and sent to the external device. By default, a preset value would be, at least the value at which no more uses are left, such as when the full number of copies have been made or when the document has been accessed the full number of times or for the full number of hours.

13. Stefik1 and Stefik2 do not specifically disclose a controller configured to inhibit the receiving unit from one of the use of and operation of the use permission data while the controller is sending the use history information. However, Stefik2 does disclose use history information, such as how many copies have been made or how many times a document has been accessed, is being monitored, updated and sent to the external device. By default, a preset value would be, at least the value at which no more uses are left, such as when the full number of copies have been made or when the document has been accessed the full number of times or for the full number of hours. (see col 21 ln 15-25). Further, at fig 17 steps 1709-1714, Stefik2 discloses checking/updating use history information, such as how many copies have already been made and based on that check permitting or not permitting the receiving unit to use or copy the data. It would be a predictable result to first check/update and only afterwards to permit the use of the data, thus in effect inhibiting the receiving unit from using the data while the

check/update/history is sent rather than letting the receiving unit start using/copying the data only to later learn that such use should not have been permitted. *KSR*

International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

14. It would be obvious to one of ordinary skill in the art to combine the teachings of Stefik1 and Stefik2 since they are clearly in the same field of digital rights management and in order to obtain greater security in digital rights management.

15. Regarding the limitation of claims 3 and 5 –

16. Stefik2 discloses wherein the digital data are one of audio data, video data, still image data, character data, computer graphics data, game software, and a computer program (e.g. col 4 ln 29-32, col 6 ln 37-50, col 3 ln 50-60).

17. Regarding claims 42, 48, and 52 –

18. Stefik2 discloses a display unit, wherein the display unit displays a message for urging a user to send the reproduction history data to the exterior element when the reproduction history data written in the memory unit reach the predetermined value. (e.g. col 8 ln 55- col 9 ln 5, table 1).

19. Regarding claim 46 –

20. Stefik2 discloses wherein the control unit sends the reproduction history data stored in the memory unit when the control unit receives data regarding an electronic monitoring permission from the exterior element, the data regarding an electronic monitoring permission being used for reproducing the content data. (e.g. col 22 ln 57- col 23 ln 10).

21. Regarding claim 49 –

22. Stefik2 discloses a second display unit, wherein the second display unit displays an indicator, the indicator changes the length of a predetermined color part in accordance with an amount of available space of the memory unit (e.g. col 8 ln 55- col 9 ln 5, table 1).

23. Regarding claim 50 –

24. Stefik2 discloses a warning display unit for displaying that the reproduction history data written in the memory unit have reached the predetermined value. (e.g. col 8 ln 55- col 9 ln 5, table 1).

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

26. Stefik et al (US 5,638,443) disclose a system for controlling the distribution and use of composite digital works.

27. Sims, III (US 6,438,235) discloses media content protection utilizing public key cryptography.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR
Examiner
Art Unit 3685

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621